

## **REMARKS**

### **Status of the Claims**

Claims 1, 5, 6, 8-30, and 35-68 are pending in this application. Claims 1, 27, 54-56, 61, and 68 are independent.

In the final Office Action, claims 1, 5, 6, 8-30, and 35-68 are rejected under 35 U.S.C. §112, first paragraph, for reciting subject matter allegedly lacking written description support in the original specification. In addition, the final Office Action rejects claims 1, 5, 6, 8-11, 14-30, 35-60, and 65-68 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sternfield et al. (U.S. Patent No. 2,665,528) in view of Smith (U.S. Patent No. 6,491,928). Further, claims 12, 13, and 61-64 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sternfield in view of Smith and Yoko (JP 04108710; hereinafter “Yoko”).

### **Rejection under 35 U.S.C. §112, First Paragraph**

In the final Office Action, claims 1, 5, 6, 8-30, and 35-68 are rejected under 35 U.S.C. §112, first paragraph, for reciting subject matter allegedly lacking written description support in the original specification. In particular, the final Office Action alleges that the specification does not include adequate support for the claim recitations of a “keratinous surface.” The final Office Action alleges that the specification only refers to “skin or hair” (citing page 1, line 5 of Applicant’s specification as an example), whereas the term keratinous surface purportedly encompasses more than merely skin or hair, and also includes plant surfaces.

Although Applicant does not necessarily agree with this rejection, Applicant has, in the interest of advancing prosecution, amended each of independent claims 1, 27,

54-56, 61, and 68 to remove the recitations of “keratinous” and to specify that the claimed surface region is that of “skin or hair.” A corresponding amendment also has been made to claim 59. Applicant respectfully submits that these amendments are supported in the original disclosure, for example, in the originally filed specification at page 1, line 5 and in original claims 1 and 7. Accordingly, no new matter has been added, and the rejection of claims 1, 5, 6, 8-30, and 35-68 under 35 U.S.C. §112, first paragraph, should be withdrawn.

#### **§ 103(a) Rejection Based on Sternfield and Smith**

The final Office Action rejects claims 1, 5, 6, 8-11, 14-30, 35-60, and 65-68 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sternfield in view of Smith. The Examiner acknowledges that Sternfield “does not explicitly teach wetting with water . . . [,] absorbent materials in the middle layer[, and] the specific adhesives as claimed[.]” Final Office Action at 5. In an attempt to cure these acknowledged deficiencies of Sternfield, the final Office Action relies on Smith for alleged teachings of these features. Final Office Action at 6. However, Applicant respectfully submits that this rejection should be withdrawn because, for at least the following reasons, the final Office Action fails to establish a prima facie case of obviousness.

Each of independent claims 1, 27, and 54-56 recites “at least one moisture-absorbing compound configured to swell within the adhesive matrix upon contact with the solvent to reduce cohesion between the adhesive matrix and the at least one active agent.” (Emphasis added.) The final Office Action alleges that this feature is satisfied by Smith’s alleged teaching of cellulose and starches that form hydrogels and, therefore, absorb water. Final Office Action at 9. In addition, the final Office Action

alleges that this claim feature is met by Smith, since “the same compounds” (i.e., cellulose and starches) are claimed by Applicant (apparently referring to Applicant’s claim 10) as compounds configured to swell and that, therefore, the materials disclosed by Smith purportedly have the same properties as those claimed by Applicant. (Id.) Applicant respectfully disagrees.

Applicant submits that there are many different types of cellulose and starches. The present claims, e.g., claim 10, specify cellulose and starch broadly. There is no indication that Smith discloses the same type of cellulose or starches as Applicant. Therefore, there is no suggestion that the materials of the reference are identical to those recited in Applicant’s claims, and thus, there is no suggestion that the properties of the cellulose and starches disclosed by Smith are identical to the properties of the cellulose and starches recited in Applicant’s claims. For example, regardless of whether these materials taught by Smith can be characterized as “moisture-absorbing,” there is no suggestion in the references that any moisture absorption of the cellulose or starches mentioned in Smith would reduce cohesion between an adhesive matrix and at least one active agent, as required by independent claims 1, 27, and 54-56. For at least this reason, the final Office Action fails to establish a prima facie case of obviousness with respect to independent claims 1, 27, and 54-56 and, accordingly, the § 103(a) rejection of these claims should be withdrawn.

In addition, Applicant maintains that there would not have been any suggestion to a person of ordinary skill in the art to combine the skin or hair cleansing article of Smith with the cleansing tissue of Sternfield that is evidently configured for scrubbing heavily-soiled surfaces, as opposed to body parts. “[R]ejections on obviousness cannot be

sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988, (Fed. Cir. 2006)). Applicant respectfully submits that the Examiner has not set forth any such articulated reasoning or rational underpinning to support the legal conclusion of obviousness based on the proposed combination of Sternfield and Smith.

Applicant submits that there would not have been any suggestion for the proposed combination of Sternfield and Smith because the embodiments of each reference that are relied upon by the Examiner are very different from one another. In particular, as argued in Applicant's previous response, the relied-upon embodiment of Sternfield is directed to treating inanimate objects, whereas the relied-upon embodiment of Smith is disclosed as a body-treating article. In response to this argument, the Examiner asserts, in the final Office Action, that Smith is not only directed to body treating embodiments, but also teaches applications for automotive care, marine vehicle care, house hold care, etc. Final Office Action at 10. The Examiner's implied allegation appears to be that it purportedly would have been obvious to combine the disclosure of Smith (broadly) with that of Sternfield because both references disclose non-body treating embodiments. This rationale, however, is misguided. The non-body treating embodiments of Smith are irrelevant because they are not relied upon in the claim rejection. In order to reject the claims in the manner the Examiner proposes, the Examiner must articulate some reason that a skilled artisan would have found it obvious to combine the body-treating embodiment of Smith with the article of Sternfield, which is

not configured for use on body surfaces. The Examiner has not provided any such reason.

For at least the foregoing additional reasons, the final Office Action has not established a prima facie case of obviousness with respect to independent claims 1, 27, 54-56, and 68. Therefore, Applicant respectfully submits that the § 103(a) rejections of these claims should be withdrawn.

#### **§ 103(a) Rejection Based on Sternfield, Smith, and Yoko**

The rejection of independent claim 61 under § 103(a), based on Sternfield in view of Smith and Yoko, fails to establish a prima facie case of obviousness, because the cited art does not disclose or suggest all of the recited claim limitations. Claim 61 includes recitations similar to those discussed above for independent claim 1. That is, claim 61 recites “at least one of the two support layers being permeable to a solvent and defining an outer surface of the composite structure, the outer surface being configured to be placed into contact with the surface region [of skin or hair].” Thus, claim 61 is distinguishable over the proposed combination of Sternfield and Smith for reasons similar to some of the reasons discussed above with respect to independent claim 1.

Yoko is cited only for an alleged teaching of a “cosmetic in adhesive matrix comprising magnetizable particles,” (final Office Action at 11-12), and fails to cure the above-noted deficiencies of Sternfield and Smith. Therefore, the cited art does not disclose or suggest all of the recited features of independent claim 61, and thus, the final Office Action fails to establish a prima facie case of obvious with respect to claim 61. Accordingly, Applicant respectfully submits that the § 103(a) rejection of independent claim 61 should be withdrawn.

## **Conclusion**

For at least the foregoing reasons, Applicant respectfully submits that each of independent claims 1, 27, 54-56, 61, and 68 is allowable. Each of claims 5, 6, 8-26, 28-30, 35-53, 57-60, and 62-67 ultimately depends from one of these allowable independent claims and, therefore, should be allowable for at least the same reasons that the respective claim from which it depends is allowable.

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing the pending claims in condition for allowance. Applicant submits that the proposed amendments of claims 1, 27, 54-56, 59, 61, and 68 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments regarding the claims. It is respectfully submitted that the entering of the Amendment would allow the Applicant to have a full and fair opportunity to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the

Examiner's reconsideration of the application, and the timely allowance of the pending claims.

The final Office Action contains a number of statements reflecting assertions and/or allegations concerning the claims and/or cited art. Regardless of whether any such statement is identified above, Applicant declines to subscribe to any assertion or allegation in the Office Action.

Please grant any additional extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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Dated: October 21, 2010

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